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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,486	02/10/2004	Seiichi Katano	49987-1003	3258

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EXAMINER	
MEDE, ESTEVE	
ART UNIT	PAPER NUMBER
2109	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/776,486	KATANO, SEIICHI	
	Examiner	Art Unit	
	Esteve Mede	2109	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *See Continuation Sheet*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :06/30/2006/ 11/07/2005/ 08/02/2004.

Specification

1. The disclosure is objected to because of the following informalities:

On page 1, [0001], line 2 of the specification the blank should be replaced by the appropriate related U.S. patent application Ser. No. On page 5, [0064], line 19 of the specification, the word "than" should be replaced by --that--. Appropriate correction is required.

Claim Objections

2. Claim 1 is objected to because of the following informalities: in claim 1, line 4 the term "detect that a request" should be --detecting that a request--; in claim 1, line 5 the term "providing data" should be --providing the data--. Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. **Claims 12, 17-26** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-15 of U.S. Co-pending Application No. 10776485.

Claim 12 discloses all the limitations of claim 1in the Co-pending Application No. 10/776485 except for one or more unauthorized instructions have been stored on the MFP. The general concept of data being stored on the MFP in order to be examined is well known in the art as an obvious storing technique and is an intrinsic property of the multi-function peripheral.

Claims 16 discloses all the limitation of claim 2 in the Co-pending Application No. 10/776,485 except that the data stored on the MFP has been modified in an unauthorized manner according to specified configuration criteria. The general concept of data being modified in an unauthorized manner is well known in the art as on obvious tampering of the data by the one or more unauthorized instructions. It would have been inherently obvious to one of ordinary skilled in the art at the time of the invention to modify Co-pending Application No. 111319255 to store data on the MFP in order to detect if the unauthorized modification of data took place, because of the one or more unauthorized instructions being stored on the MFP.

Claim 16 discloses all limitations of claim 3 in the Co-pending Application No. 10776485 except to detect modification of program code stored on the MFP by the one or more unauthorized instructions. The general concept of program code

being modified in an MFP by one or more unauthorized instructions is well known in the art as an obvious tampering of the program code by the virus. It is an intrinsic tampering property of the one or more unauthorized instructions to behave in such a manner.

Claim 16 discloses all limitations of claim 4 in the Co-pending Application No. 10/776,485 except to detect modification of configuration data stored on the MFP by the one or more unauthorized instructions. The general concept of program code being modified in an MFP by one or more unauthorized instructions is well known in the art as an obvious tampering of the configuration data by the virus. It is an intrinsic tampering property of the one or more unauthorized instructions to behave in such a manner.

Claim 16 discloses all limitations of claim 5 in the Co-pending Application No. 10776485 except to detect modification of configuration data stored on the MFP by the one or more unauthorized instructions. The general concept of program code being modified in an MFP by one or more unauthorized instructions is well known in the art as an obvious tampering of the configuration data by the virus. It is an intrinsic tampering property of the one or more unauthorized instructions to behave in such a manner.

Claim 17-26 discloses all limitations of claims 6-15 in the Co-pending Application No. 10/776,485.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement

thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. **Claims 1-26** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In independent claim 1, 8, and 12 are drawing towards multi-function device comprising: a memory storing instructions, when processed by processors cause the MFP to detect a request for data that need to be scanned for viruses, in response to detecting receipt of the request, providing data from the MFP device to the network over the network. In order for the claimed invention as claimed to be statutory, it must result in useful, concrete and tangible result. In this instance there is not result of the claimed invention as claimed; there mere act of responding to detecting receipt of the request providing data from the MFP device to the network device over the network does not result in any real world change as it does not cause any action outside the claimed invention. Therefore the claimed invention as claimed does cause any tangible output result.

Dependent claims 2-4, 7, 8-9, 11, 12-13, 15-16, 18-21 are rejected for being dependent upon rejected claim 3 and 9, and for failing to meet statutory requirements of the base claims 1, 8 and 12.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 1-3, 7-8, 10-16, 19, 21**, are rejected under 35 U.S.C 102(b) as being anticipated by Boldon et al. (US 2003/0048468 A1).

Regarding claim 1 Boldon discloses a memory storing device instructions which, when processed one more processors, causes the multi-function peripheral to perform the steps of (paragraph. 0016, lines 8-12) detect that a request for data to be analyzed for viral infection has been received over a network from a network device (paragraph 0019, lines 3-7; paragraph 0016, lines 5-8); and in response to detecting receipt of the request, providing data from the multi-function peripheral device to the network device over the network (paragraph 0016, lines 12-14).

Regarding claim 2-3, Boldon discloses wherein providing data from the multi-function peripheral device to the network device over the network includes providing one or more data files to the network device over the network (paragraph 0016, lines 5-8); configuring data to the network device over the network (the prior art discloses information are sent to the device over a network that will change the functionality the way the device perform its job, although the prior art did not specifically uses the work "configuration", it is a fact that configuration is taking place base on instructions received (paragraph, 0016, lines 8-14).

Regarding claims 8 and 10-11 and 15, Boldon discloses a virus protection process configured to, upon receipt of data by the multi-function peripheral, examine the data to determine whether the data contains one or more unauthorized instructions

perform one or more actions (it is factual and accurate that viruses must be executable program codes in order for the virus to work (paragraph 0022, lines 3-10; paragraph 0019, lines 3-9)).

Regarding claim 7 Boldon discloses instruction when processed by one or more processors cause multi-function peripheral to perform the step of: receive a request from the network device for the multi-function peripheral to quarantine or delete at least a portion of the data that was sent from the multi-function peripheral device to the network device (paragraph 0023. lines 1-5); and response to receiving the request from the network device to quarantine or delete at least a portion of the data that was sent to the network device, quarantine or delete the at least a portion of the data that was sent from the multi-function peripheral device to the network device (paragraph 0006, lines 4-7; paragraph 0007, lines 4-7; paragraph 0016, lines 5-14)

Regarding claim 12 Boldon discloses a virus protection process configured to, prior to sending data from the multi-function peripheral to a network device over a network, examine the data to determine whether the data contains one or more unauthorized (paragraph 0006, lines 4-7; paragraph 0003, lines 11-14); in response to determining that the data contains one or more unauthorized instructions, performs one or more actions (paragraph 0007, lines 4-7; paragraph 0016, lines 12-14).

Regarding claim 13 Boldon discloses one or more actions include not sending the data to the network device (it is factual in order for a information to be transmitted to a network, the information must be first exist; the prior art discloses that upon detection of a virus one of the actions that may taking place is deleting the information that

contain the virus base on the filter, therefore infected file would not be sent to the network (paragraph 003, lines 11-14; paragraph 0007, lines 4-7)).

Regarding claim 14 Boldon discloses the one or more actions include generating and providing a notification that indicates that the multi-function peripheral has the data that has been infected by a virus (paragraph 0007, lines 4-7).

Regarding claim 16, Boldon discloses the virus protection process is configured to detect that one or more unauthorized instructions have been stored on the multi-function peripheral by examining and detecting that the data has been modified (paragraph 0006, lines 4-7).

Regarding claim 18, Boldon discloses all the limitation of claim 18 except that the data is stored in volatile memory. The general concept of storing data in volatile memory is well known in the art as illustrated by Walsh, which discloses the system memory includes a random access memory (RAM), which is a volatile type of memory (column 8, lines 11-13). Therefore it would have been obvious for one of ordinary skill in the art at the time of the invention to include the use of volatile memory in order to access data that need to be processed.

Regarding claim 19 Boldon discloses the virus protection process is further configured to undo changes made as a result of execution of the one or more unauthorized instructions (paragraph 00016, lines 8-12).

Regarding claim 21 Boldon discloses the virus protection process is further configured to render the data inaccessible on the multi-function peripheral (the prior did not use the phrase inaccessible, however the prior disclose upon detection of a virus

that the data will be deleted, therefore deleting the data will render the it inaccessible (paragraph 0019, lines 5-8).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Boldon et al. (US 2003/0048468 A1) in view of Kouznetsov (US 2004/0025042 A1).

Regarding claims 4-6 Boldon discloses all the limitation of claims 4-6, except that receiving replacement data for the multi-function peripheral (paragraph 0161, lines 1-2; paragraph 016, lines 1-2); generate and send a conformation message to the network device (paragraph 0341, lines 5-7; lines 11-13); and generate a report and either print the report or fax the report (paragraph 0377, lines 1-5; see table 68c; paragraph 0078, lines 6-7). The general concept of replacing the data, send a conformation message to the network device and generate a report via fax or a printer to another location is well known in that art as illustrated by Kouznetsov, which discloses data replacement after deleting action had taken place, generating a report a component manager and send a conformation message out to the device (client). Therefore it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Boldon to include the use of data replacement, report

generation and conformation in order for the virus scanner to perform certain task such as generating a report to system administration or user confirming that the replacement data is free of infection base on define criteria set forth by the administrator at the time of configuration.

11. **Claim 9, 17-26** are rejected under 35 U.S.C. 103(a) as being unpatentable over Boldon et al. (US 2003/0048468 A1) in view of Walsh et al. (US 5,956,481).

Regarding claim 9 Boldon discloses all the limitation of claim 9 except that the wherein the virus protection process is further configured to prevent the data from being stored on the multi-function peripheral. The general concept of preventing infected data from being stored in the multi-function peripheral is well known in the art as illustrated by Walsh, which discloses preventing a virus from loading and infect other systems (column 11, lines 59-67). Therefore it would been obvious for one or ordinary skill in the art at the time of the invention to modify Boldon to include the use of preventing the infected data access to storage in order to prevent the virus from spreading to other area in the system as recited in column 11, lines 64-66.

Regarding claim 20 Boldon discloses all the limitation of claim 20 except that determining whether the data stored on the multi-function peripheral can be restored to a prior state. The general concept of re-storing infected data after the infected data have been cured is will know in the art as illustrated by Walsh, which disclose removing the virus from the infected date (file). Therefore it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Boldon to include to the use

of re-storing a file after the virus has been removed from it in order to recover the original data, as re-storing the data is the main purpose of recovering data from a virus.

Regarding claim 22-25 Boldon discloses all the limitation of claim 22-25 except for the method of contacting the user is being made by graphical user interface, printer, email or facsimile. The general concept of displaying the notification via a graphical user interface is well known in the art as illustrated by Walsh, which discloses that a notification is sent to the user by a user interface displayed on a computer monitor (column 3, lines 21-22; column 10, lines 12-16). Therefore it would have been obvious for one of ordinary skilled in the art at the time of the invention to modify Boldon to include the use of a display monitor, printer, email and facsimile in order to present options for responding to the infected data.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Esteve Mede whose telephone number is 571-270-1594. The examiner can normally be reached on Monday thru Friday, 8:30-5:00 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frantz Jules can be reached on 571-272-6681. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Esteve Mede
EM
February 2, 2007

FRANTZ JULES
SUPERVISORY PATENT EXAMINER